PATENT

Atty Docket No.: 200308989-1
App. Ser. No.: 10/734,153

REMARKS

Favorable reconsideration of this application is respectfully requested in view of amendments above and the following remarks.

By virtue of the amendments above, claims 1, 5, 8, 13, 15, 17, 21, and 25, have been amended and claims 3, 9, and 23 have been previously canceled without prejudice or disclaimer of the subject matter contained therein. Accordingly, claims 1-2, 4-8, 10-22, and 24-27 are pending in the present application of which claims 1, 8, 15, and 21 are independent.

Claims 1, 4, 6, 7, 15, 16, 21, 24, 26 and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nose et al. (4,998,016) in view of Hoen et al. (6,411,589).

Claims 2, 8, 10, 11, 12, 20 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nose et al. (4,998,016) in view of Hoen et al. (6,411,589) further in view of Azuma et al. (6,477,132).

Claims 5, 13, 14, 17, 18, 19 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent for including all of the limitations of the base claim.

All of the rejections are traversed.

Allowable Subject Matter

The Office action indicates that dependent claims 5, 13, 17, and 25 contain allowable subject matter. In this regard, independent claims 1, 8, 15, and 21 have been amended to include allowable subject matter of dependent claims 5, 17, and 25 respectively. At least by virtue of the above-amendments, it is respectfully submitted that these claims are now in

condition for allowance. Therefore the Examiner is respectfully requested to allow the claims.

Claim Rejections Under 35 U.S.C. §103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in KSR International Co. v. Teleflex Inc., 550 U.S._, 82 USPQ2d 1385 (2007):

> Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. [Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).]

As set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, "[a]ll claim limitations must be considered" because "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970). According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of KSR International Co. v. Teleflex Inc., Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the Graham factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

> (A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) "Obvious to try"—choosing from a finite

> number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S._, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in KSR International Co. v. Teleflex Inc., *quoting* from In re Kahn, 441 F.3d 977, 988 (CA Fed. 2006), "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness."

Therefore, if the above-identified criteria and rationales are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 1, 4, 6, 7, 15, 16, 21, 24, 26 and 27

Claims 1, 4, 6, 7, 15, 16, 21, 24, 26 and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nose et al. (4,998,016) in view of Hoen et al. (6,411,589).

Considering independent claims 1 and 21, independent claim 1, as amended, recites "a heater disposed on the second electrode." Independent claim 21, as amended, recites "a heater disposed on the second electrode." Support can be found at least, for instance, in original dependent claims 5 and 17 respectively.

Nose et al. fails to teach or suggest these claimed features. Nose et al. teaches that the symmetrical structure of the probe unit alleviates concern of lengthwise thermal expansion. Specifically, Nose et al. discloses that position deviations from thermal expansion seldom occur because of the symmetrical structure of the probe unit (column 12, lines 27-35).

Initially, it is noted that the Examiner has admitted that Nose et al. does not explicitly teach a heater. Moreover, the Examiner has stated that the purpose of a heater is to "protect the thermal expansion of the probe from damage." Essentially therefore, Nose et al. appears to teach away from even needing a heater.

Hoen et al. also fails to make up for the deficiency of Nose et al. The Office Action cites Hoen et al. for the purpose of alleging that it teaches 1) a plurality of flexible extension members - #82 of FIG. 2A; 2) motive to resist motion- column 7 at lines 35-37; 3) application of a voltage to an electrode - column 11, lines 39-46; and 4) electrically conductive material - column 15 at lines 13-16. In this regard, the Office Action does not even allege that Hoen et al. makes up for the deficiency in Nose et al.

Independent claim 15, as amended, recites the feature "configuring one pair of flexures to be integral with the second electrode and a second pair of flexures to be connected to the second electrode through an electrically insulative member." Support can be found at least, for instance, in original dependent claim 17. The Office Action emphasizes that this particular feature is the allowable subject matter of dependent claim 17.

Accordingly, Nose et al. in view of Hoen et al. fails to teach or suggest all of the features of independent claims 1, 15, and 21. Therefore, a *prima facie* case of obviousness has not been established under 35 USC § 103. The Examiner is therefore respectfully requested to withdraw the rejection and allow these claims and their dependent claims.

Claims 2, 8, 10, 11, 12, 20 and 22

Claims 2, 8, 10, 11, 12, 20 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nose et al. (4,998,016) in view of Hoen et al. (6,411,589) further in view of Azuma et al. (6,477,132).

Independent claim 8, as amended, recites "a heater supported on the second electrode." Support can be found at least, for instance, in original dependent claim 13. Due to at least the above-discussed reasons, Nose et al. in view of Hoen et al. fails to teach or suggest a heater as claimed in amended independent claims 8.

Azuma et al. also fails to teach or suggest the claimed heater. Azuma et al. was cited as allegedly teaching 1) a capacitance which varies with displacement of the probe with respect to the medium -column 65 at lines 58-62; 2) sensing displacement of a probe with respect to the medium which displacement is induced by engagement between a probe; 3) a capacitor means and data indicative of a topographical feature - column 5 at lines 58-62; and 4) a linear acting electrostatic motor means -column 5 at lines 46-58. In this regard, the Office Action does not even allege that Azuma et al. makes up for the deficiency of the combination of Nose et al and Hoen et al.

Thus, if the rejection is maintained, the Examiner is respectfully requested to point out where these features are found in Azuma et al. and also explain how these features could be combined with Nose et al. which, per the above-discussion, appears to teach away from these features.

Therefore, a *prima facie* case of obviousness has not been established under 35 USC § 103. The Examiner is therefore respectfully requested to withdraw the rejection and allow claims 2, 8, 10, 11, 12, 20 and 22.

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Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: May 19, 2008 By

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